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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,044	11/21/2003	Steven J. Smith	MNDSh-01006US0 MCF/JXG	5039
23910	7590	07/24/2008	EXAMINER	
FLIESLER MEYER LLP 650 CALIFORNIA STREET 14TH FLOOR SAN FRANCISCO, CA 94108			DAILEY, THOMAS J	
			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/721,044	Applicant(s) SMITH ET AL.	
	Examiner THOMAS J. DAILEY	Art Unit 2152	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28, 45-51 and 60-67 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28, 45-51 and 60-67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/3/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 60-67 were added by the amendment filed on April 3, 2008.
2. Claims 29-44 and 52-59 were cancelled by the amendment filed on April 3, 2008.
3. Claims 1-28, 45-51, and 60-67 are pending.

Response to Arguments

4. The U.S.C. 112 second paragraph rejections directed at claims 3-5, 11-13, 17-19, 25-27, 33-34, 41-42, 49-50, 56-57 are withdrawn in light of the applicant's entered amendment.
5. Applicant's arguments with respect to claims 1-28, 45-51, and 60-67 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-28, 45-51, and 60-67 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claim 1 recites, "checking for the token containing the *petition in the recipient*," (line 12) and "if the token is found *in the recipient*," (line 13). These limitations are unclear. How can a petition or token be found *in* a recipient? It appears it should be something the recipient controls, not the actual recipient.
9. Claim 7 recites, "searching *in the recipient for...*" (line 12) and "if the token is found *on the recipient*," (line 14). These limitations are unclear. How can a petition or token be searched for and found *in or on* a recipient? It appears it should be something the recipient controls, not the actual recipient.
10. As to claims 15 and 45, they are rejected by the same rationale set forth in claim 1's rejection.
11. As to claim 21, it is rejected by the same rationale set forth in claim 7's rejection.
12. Claims not previously addressed are rejected due to their dependence on the above rejected claims.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1, 3-9, 11-15, 17-23, 25-28, 45-51, 60-61, 63-65, and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heiner (US Pat. 6,112,227, cited on IDS dated 8/23/2004) in view of Kirsch (US Pat. 6,546,416).

15. As to claim 1, Heiner discloses a method for modifying mail filters associated with a user of a mail system, the method comprising:

receiving a subscription request by a sender, the subscription request including user information (column 3, lines 43-50, a source client (sender) requests to register its email address as valid);

generating a petition by the sender based on the user information, the petition comprising a request for the sender to be added to a list of approved mail senders, the list associated with the user (column 3, lines 56-62, source client sends a reply (petition) to register and become a valid sender);

transmitting the petition from the sender to a recipient as a result of the subscription request and storing said petition at the recipient (column 3, lines 56-62);

receiving a login request from the user to the mail system (column 3, lines 39-48, as there is a destination SMTP server, the recipient will inherently login to retrieve emails);

checking for the petition in the recipient (column 3, lines 56-62); and

processing said the petition if the token is found in the recipient and modifying the mail filters associated with the user by adding the sender to the list of approved mail senders as specified in the petition (column 3, lines 56-62).

But, Heiner does not explicitly disclose a token containing the petition. Rather, Heiner discloses the petition is composed of a response to a destination client and each destination client is allowed to compose their own questions or instructions required to submit a valid petition (column 3, lines 56-67).

However, as Kirsh discloses generating and transmitting a digital signature containing a valid petition to add a sender to an approved sender list (column 3, lines 43-57, a digital signature (token) is transmitted to verify a sender).

As Heiner discloses each destination client is allowed to compose their own questions or instructions that, when followed, creates a valid petition and Kirsh discloses a digital signature constituting a valid petition, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Heiner and Kirsh thus improving the means for verifying senders.

16. As to claim 7, Heiner discloses a method for modifying mail filters associated with a user of a mail system, the method comprising:

receiving a subscription request to a sender, the subscription request including user information (column 3, lines 43-50, a source client (sender) requests to register its email address as valid);

generating a petition by the sender based on the user information, the petition comprising a request for the sender to be added to a list of approved mail senders, the list associated with the user (column 3, lines 56-62, source client sends a reply (petition) to register and become a valid sender);

transmitting petition from the sender to a recipient a reference to a location of the as a result of the subscription request and storing said petition at the recipient (column 3, lines 56-62);

receiving a login request from the user to the mail system (column 3, lines 39-48, as there is a destination SMTP server, the recipient will inherently login to retrieve emails);

searching in the recipient containing the reference to a location of the petition (column 3, lines 56-62); and

retrieving said the petition from said location if the token is found in the recipient and modifying the mail filters associated with the user by adding the sender to the list of approved mail senders as specified in the petition (column 3, lines 56-62).

But, Heiner does not explicitly disclose a token containing the petition. Rather, Heiner discloses the petition is composed of a response to a destination

client and each destination client is allowed to compose their own questions or instructions required to submit a valid petition (column 3, lines 56-67).

However, as Kirsh discloses generating and transmitting a digital signature containing a valid petition to add a sender to an approved sender list (column 3, lines 43-57, a digital signature (token) is transmitted to verify a sender).

As Heiner discloses each destination client is allowed to compose their own questions or instructions that, when followed, creates a valid petition and Kirsh discloses a digital signature constituting a valid petition, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Heiner and Kirsh thus improving the means for verifying senders.

17. As to claims 15 and 45, they are rejected by the same rationale set forth in claim 1's rejection.

18. As to claim 21, it is rejected by the same rationale set forth in claim 7's rejection.

19. As to claims 3, 11, 17, and 25, Kirsch discloses the petition specifies an identification method that will be used to verify that an email message is from a given sender (column 3, lines 43-57).

20. As to claims 4, 12, 18, and 26, Kirsch discloses the identification method utilizes an origin electronic mail address for the sender (column 3, lines 43-57).

21. As to claims 5, 13, 19, and 27, Kirsch discloses the identification method utilizes a digital signature (column 3, lines 43-57).

22. As to claims 6, 14, 20, 28, and 51, Kirsch discloses the user information comprises a user identifier (column 3, lines 43-57).

23. As to claims 8 and 22, Kirsch discloses receiving a request for the petition from a party maintaining the list of approved mail senders and transmitting the petition in response to the request for the petition (column 3, lines 58-67, computer sends challenge email soliciting a petition to be added to verified source address list).

24. As to claim 9 and 23, Kirsch discloses including authentication credentials in the token and receiving authentication credentials with the request for the petition (column 3, lines 58-67).

25. As to claim 46, Kirsch discloses the token includes the petition (column 3, lines 58-67, challenge reply includes petition information (i.e. the data necessary to add the sender to the verified source address list)).

26. As to claim 47, Kirsch discloses the token includes a reference to a petition location (column 7, lines 22-35, a challenge reply (email containing the petition) is received and evaluated, inherently a reference to the location of the petition is given as the challenge reply is actively evaluated).

27. As to claim 48, Kirsch discloses the petition specifies an identification method that will be used to verify that an email message is from a given sender (column 3, lines 43-57).

28. As to claim 49, Kirsch discloses the identification method utilizes a sender mail address (column 3, lines 43-57).

29. As to claim 50, Kirsch discloses the identification method utilizes a digital signature (column 3, lines 43-57).

30. As to claims 60 and 64, Kirsch discloses requesting a confirmation of the success of the petition by the sender; and transmitting a confirmation of the petition from the recipient to the sender indicating success or denial of the petition (column 10, lines 25-38).

31. As to claims 61 and 65, Kirsch discloses the sender assumes that the petition was denied by the recipient if confirmation was requested by the sender but never received from the recipient (column 3, 45-57)

32. As to claims 63 and 67, Kirsch discloses maintaining a petition rules list that specify special handling of the petition based on the data contained in the petition such that the petition rule list identifies recipients whose petition processors are located on the systems of a remote mail provider (column 3, lines 43-57).

33. Claims 2, 10, 16, 24, 62, and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heiner in view of Kirsch, as applied to claims 1, 7, 15, and 21, in view of what is well known in the art.

34. As to claims 2, 10, 16, and 24, Heiner and Kirsch do not explicitly disclose the token is a cookie. However, Official Notice (see MPEP 2144.03 Reliance on "Well Known" Prior Art) is taken one of ordinary skill in the art at the time of the invention would view it as an obvious modification of Kirsch to utilize a cookie to store the petition to the user, as a cookie is a common means to organize data in the art.

35. As to claims 62 and 66, Heiner and Kirsch fail to disclose the token containing the petition is transmitted from the sender to the recipient via hypertext transfer

protocol (HTTP). However, Official Notice (see MPEP 2144.03 Reliance on "Well Known" Prior Art) is taken one of ordinary skill in the art at the time of the invention would view it as an obvious modification of Heiner and Kirsch to utilize known protocol to generate and store a digital signature as a HTTP is a widely used protocol in emails and the Internet in general.

Conclusion

36. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
37. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.
38. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Dailey whose telephone number is

571-270-1246. The examiner can normally be reached on Monday thru Friday;
9:00am - 5:00pm.

39. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571-272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

40. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. J. D./
Examiner, Art Unit 2152

/Bunjob Jaroenchonwanit/
Supervisory Patent Examiner, Art Unit 2152